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SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/157,195	12/08/93	HENCO	P965024080 K

TRAN, P — EXAMINER

18N1/1130

WEGNER, CANTOR, MUELLER & PLAYER
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WASHINGTON, DC 20036-8218

ART UNIT	PAPER NUMBER
1807	5

DATE MAILED: 11/30/94

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

☑ This application has been ~~examined~~ restricted only. ☐ Responsive to communication filed on _____ ☐ This action is made final.

A shortened statutory period for response to this action is set to expire 0 month(s), 30 days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1. ☐ Notice of References Cited by Examiner, PTO-892.
2. ☐ Notice re Patent Drawing, PTO-948.
3. ☐ Notice of Art Cited by Applicant, PTO-1449.
4. ☐ Notice of Informal Patent Application, Form PTO-152.
5. ☐ Information on How to Effect Drawing Changes, PTO-1474.
6. ☐ _____

Part II SUMMARY OF ACTION

1. ☑ Claims 1-38 are pending in the application.
   Of the above, claims _____ are withdrawn from consideration.
2. ☐ Claims _____ have been cancelled.
3. ☐ Claims _____ are allowed.
4. ☐ Claims _____ are rejected.
5. ☐ Claims _____ are objected to.
6. ☑ Claims 1-38 are subject to restriction or election requirement.
7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
8. ☐ Formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable. ☐ not acceptable (see explanation or Notice re Patent Drawing, PTO-948).
10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on _____ has (have) been ☐ approved by the examiner. ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed on _____, has been ☐ approved. ☐ disapproved (see explanation).
12. ☐ Acknowledgment is made of the claim for priority under U.S.C. 119. The certified copy has ☐ been received ☐ not been received ☐ been filed in parent application, serial no. _____ ; filed on _____
13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other

EXAMINER'S ACTION

PTOL-326 (Rev. 9-89)

08/157,195

Election/Restriction

The instant application is filed under 35 U.S.C. 371. However, due to the prior art teaching of the special technical feature of the invention, psoralen-DNA (or functionally equivalents thereof), as evidenced by Jinno et al. (Applicant's IDS in Form 1449), which teaches the use of psoralen to eliminate contaminant DNA during PCR, no unity of invention is hereby observed. The following restriction thus results:

Restriction to one of the following inventions is required under 35 U.S.C. 121:

Group I, Claims 1-26, drawn to methods of detection by nucleic acid amplification, classified in Class 435, subclasses 6 and 91.1.

Group II, Claims 27-30, drawn to oligonucleotides or probes, classified in Class 435, subclass 6; and Class 536, subclass 24.33.

Group III, Claims 31 and 32, drawn to a device for operating nucleic acid amplification, classified in Class 435, subclass 290.

Group IV, Claims 33-38, drawn to a means for operating nucleic acid amplification, classified in Class 435, subclass 6.

The inventions are distinct, each from the other because of the following reasons:

Inventions II and I are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (M.P.E.P. § 806.05(h)). In the instant case the oligonucleotides or probes

of Group II can be used as detecting probes via non-amplification nucleic acid hybridization.

Inventions I and III/IV are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (M.P.E.P. § 806.05(e)). In this case, the process of Group I can be practiced by hand, e.g. by transferring the reaction to different water baths having different temperature as required by the amplification process.

Invention II are patentably distinct from Inventions III and IV. The former is drawn to an oligonucleotide while the formers are to a mechanical device or a means to amplify nucleic acids.

Invention III is patentably distinct from Invention IV. The former is drawn to a device whereas the latter is to a means to amplify nucleic acids. They differ because each is drawn to different apparatus or the means to carry out the process of amplification. That is, each invention requires a different experimental set up and operation.

Because these inventions are distinct for the reasons given above, and have acquired a separate status in the art as shown by their different classification or have acquired a separate status because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

A telephone call was made to William E. Player on November 22, 1994, to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. § 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 C.F.R. § 1.48(b) and by the fee required under 37 C.F.R. § 1.17(h).

Any inquiry concerning this communication or those earlier from the Examiner should be directed to Paul B. Tran, Ph.D. whose telephone number is (703) 308-4040. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose phone number is (703) 308-0196.

Paper related to this application may be submitted to Group 1800 by facsimile transmission. Papers should be faxed to Group 1800 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The CM1 Fax Center number is (703) 305-3014.

Paul B. Tran, Ph.D.
Art Unit 1807
11/28/94

M. Parr 11-29-94
MARGARET PARR
SUPERVISORY PATENT EXAMINER
GROUP 1800